



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Ken Dubuc, et al.

Title: METHOD AND APPARATUS FOR COMMUNICATING DATA
PACKETS ACCORDING TO CLASSES OF SERVICE

App. No.: 09/998,504

Filed: 11-30-2001

Examiner: Wong, Blanche

Group Art Unit: 2619

Atty. Dkt. No. 1400.1373460

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Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Claims 1, 4-11 and 13-33 are pending in the application. The Examiner has rejected claims 1, 4-11, 13-20, 26 and 27. The Examiner has objected to claims 21-25 and 28-33. Applicant respectfully requests reconsideration of claims 1, 4-11 and 13-33. Appellant files herewith a notice of appeal. Pursuant to the "New Pre-Appeal Brief Conference Pilot Program," 1296 Off. Gaz. Pat. Office 67 (July 12, 2005) and the "Extension of the Pilot Pre-Appeal Brief Conference Program" dated 1/10/2006, Appellant submits a pre-appeal brief request for review. The review is requested for the reasons set forth below:

Applicant submits there exist clear errors in the Examiner's rejections and/or the Examiner's omissions of one or more essential elements needed for a prima facie rejection. Applicant submits the Examiner's "Response to Arguments" provides evidence that the Examiner has failed to consider the pending claims as required by the Manual of Patent Examining Procedure (MPEP) and prevailing case law. For enablement under 35 U.S.C § 112, first paragraph, in accordance with MPEP § 2164.01, the "standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied." Moreover, in accordance with MPEP § 2164.01(b), "As long as

the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970)." For 35 U.S.C. § 112, second paragraph, in accordance with MPEP § 2173.02, "The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

(A) The content of the particular application disclosure;

(B) The teachings of the prior art; and

(C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made."

For anticipation under 35 U.S.C. § 102, a reference must teach every aspect of the claimed invention either explicitly or implicitly. Any feature not directly taught must be inherently present [emphasis added]. See MPEP § 706.02 – distinction between 35 U.S.C. § 102 and § 103. Applicant submits MPEP § 2131 provides: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). 'The identical invention must be shown in as complete detail as contained in the...claim.' *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim." As Applicant describes in detail below, Applicant submits there exist clear errors in the Examiner's rejections and/or the Examiner's omissions of one or more essential elements needed for a *prima facie* rejection.

The Examiner has rejected claims 1, 4-11 and 13-18 under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement. Applicant respectfully disagrees.

Regarding claims 1 and 10, while the Examiner states, "...neither Fig. 1 nor the Specification discloses the same set of the plurality of transport interfaces shared by the service interface and the second service interface," Applicant notes claim 1 does not recite "...the same set of the plurality of transport interface shared by the service interface and the second service interface" and, moreover, Applicant submits, for example, Fig. 4 and page 19, lines 26 and 27, of the specification disclose

"Service interface 401 is coupled to service interface 403 via a bundle 407 of transport interfaces 410, 411, 412, and 413." Thus, Applicant submits, consistent with MPEP § 2164.01(b), "the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim." Accordingly, Applicant submits "the enablement requirement of 35 U.S.C. 112 is satisfied." Thus, Applicant submits clear errors exist in the Examiner's rejection under 35 U.S.C. §112, first paragraph. Therefore, Applicant submits claims 1 and 10 are in condition for allowance.

The Examiner has rejected claims 1, 4-9 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter. Applicant respectfully disagrees.

Regarding claim 1, the Examiner states, "it is unclear how/why 'a differentiated service profile [is] associated with the service interface' in lines 5 but 'a second differentiated service profile [is] operatively coupled to the second service interface' in lines 12-13, or whether there is a difference between 'associated' and 'operatively coupled.'" Applicant submits the Examiner fails to show any analysis of claim 1 in light of the "content of the particular application disclosure," the "teachings of the prior art," and the "claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made." Thus, Applicant submits clear errors exist in the Examiner's rejection under 35 U.S.C. §112, second paragraph. Therefore, Applicant submits claim 1, 4, and 6-9 are in condition for allowance.

Regarding claim 5, the Examiner states, "it is unclear whether 'the differentiated service profile' in line 3 is the second differentiated service profile because claim 5 recites 'the second service interface' in line 1 and the second service interface is associated with the second differentiated service profile, not 'the differentiated service profile.'" Applicant submits antecedent basis for "the differentiated service profile" in line 3 of claim 5 is found in line 5 of claim 1, from which claim 5 indirectly depends. Moreover, Applicant submits the Examiner fails to show any analysis of claim 5 in light of the "content of the particular application disclosure," the "teachings of the prior art," and the "claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made." Thus, Applicant submits clear errors exist in the Examiner's rejection under 35 U.S.C. §112, second paragraph. Therefore, Applicant submits claim 5 is in condition for allowance.

The Examiner has rejected claims 19, 20 and 26, 27 under 35 U.S.C. §102(e) as allegedly being anticipated by Kuykendall, Jr. (US Publication No. US 2002/0181044). Applicant respectfully disagrees.

Regarding claims 19 and 26, Applicant submits the cited portions of the cited reference fail to disclose or suggest the subject matter of claims 19 and 26. As one example, Applicant submits the cited portions of the cited reference fail to disclose or suggest "...wherein the classes of service of the subsets of the data packets carried by the transport interfaces are unique to each of the transport interfaces." While the Examiner cites "(circuit switched, IP telephone, ISP backbone, CATV, 19-22 in Fig. 4)," Applicant submits Fig. 4 does not illustrate, for example, "...the classes of service of the subsets of the data packets...." Moreover, Applicant submits the description of "FIG. 4" in paragraph [0087] of the specification of the cited reference appears to fail to describe elements 19, 21, and 22. To the extent "the IP based telephone networks 20" is mentioned, Applicant submits such reference pertains to "networks" and does not disclose a class of service. Accordingly, Applicant submits the cited portions of the cited reference do not "teach every aspect of the claimed invention either explicitly or implicitly," in accordance with MPEP § 706.02. Thus, Applicant submits the Examiner has not made a *prima facie* showing of anticipation. Therefore, Applicant submits claims 19 and 26 are in condition for allowance.

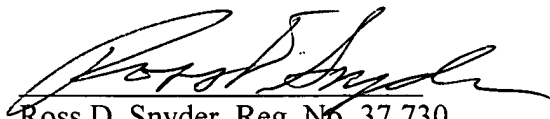
Regarding claims 20 and 27, Applicant submits the cited portions of the cited reference fail to disclose or suggest the subject matter of claims 20 and 27. As one example, Applicant submits the cited portions of the cited reference fail to disclose or suggest "...wherein the transport interfaces are operably coupled to the service interface in bundles, each bundle having exactly one of the transport interface for each of the classes of service." While the Examiner cites "(circuit switched, IP telephone, ISP backbone, CATV, 19-22 in Fig. 4)" as allegedly disclosing "each bundle having exactly one of the transport interfaces for each of the classes of service," Applicant submits Fig. 4 does not illustrate, for example, "...the classes of service." Moreover, Applicant submits the description of "FIG. 4" in paragraph [0087] of the specification of the cited reference appears to fail to describe elements 19, 21, and 22. To the extent "the IP based telephone networks 20" is mentioned, Applicant submits such reference pertains to "networks" and does not disclose or suggest a class of service. Accordingly, Applicant submits the cited portions of the cited reference do not "teach every aspect of the claimed invention either explicitly or implicitly," in accordance with MPEP § 706.02. Thus, Applicant submits

the Examiner has not made a *prima facie* showing of anticipation. Therefore, Applicant submits claims 20 and 27 are in condition for allowance.

Respectfully submitted,

Date

03/26/2009



Ross D. Snyder, Reg. No. 37,730

Attorney for Applicant(s)

Ross D. Snyder & Associates, Inc.

PO Box 164075

Austin, Texas 78716-4075

(512) 347-9223 (phone)

(512) 347-9224 (fax)